

C3 540-137 32. A system as claimed in claim 28, wherein the controller further includes polarity means for selectively altering transmission of energy from the electrodes between a unipolar ablation mode and a bipolar ablation mode in response to a second predetermined input command.

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## REMARKS

### I. PRELIMINARY REMARKS

Claims 12 and 16-20 has been amended. Claims 28-32 have been added. Claims 21-27 have been canceled. Claims 1-20 and 28-32 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

### II. BRIEF DESCRIPTION OF THE ILLUSTRATED EMBODIMENTS

The present invention, as defined by claims 1-20 and 28-32, is directed generally to a system for ablating tissue. As shown by way of example in FIG. 59, the system 298 includes a controller 300 and probe 180 that may be inserted into the body. The probe includes an ablation element 176(1) which, in the exemplary embodiment, consists of a plurality of conductive regions E1 to E7 that form an energy emitting region 192.

As discussed in the specification from, for example, page 53, line 31 to page 58, line 17 and as illustrated for example in FIGS. 59-66, the exemplary controller 300 can be used to selectively switch the operation of the electrodes between unipolar and bipolar ablation modes. The controller 300 can also be used to selectively energize some or all of the respective conductive regions E1 to E7 to form a variety of lesion patterns.

### III. REJECTION UNDER SECTION 102

Claims 12-16 have been rejected under 35 U.S.C. § 102 as being anticipated by the Kittrell patent. The rejection under 35 U.S.C. § 102 is respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

The Kittrell patent is directed to a catheter for laser angiosurgery which includes a plurality of optical fibers that can be aimed at tissue. As such, the Kittrell patent fails to teach or suggest a combination of elements including, *inter alia*, a guide element for introduction into a body and **at least one energy transmitting electrode defining an energy transmitting region on the guide element**, as recited in independent claim 12.

"A rejection for anticipation under section 102 requires that **each and every** limitation of the claimed invention be disclosed in a single prior art reference." *In re Paulsen*, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). As the Kittrell patent fails to teach or suggest each and every element in the combination defined by claim 12, applicant respectfully submits that claims 12-16 are patentable thereover and that the rejection under 35 U.S.C. § 102 must be withdrawn.

### IV. REJECTION UNDER SECTION 103

#### 1. The Rejection

Claims 1-20 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Houser patent and Mackey article. The rejection under 35 U.S.C. § 103 is respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

## 2. Legal Standards

Under the sixth paragraph of 35 U.S.C. § 112, for a means-plus-function limitation to read on a device, the device “must employ means identical to or the equivalent of the structure material, or acts described in the patent specification” and “must also perform the identical function as specified in the claims.” *Valmont Industries, Inc. v. Reinke Mfg. Co., Inc.*, 25 USPQ2d 1451, 1454 (Fed. Cir. 1993). This mandate applies to patentability determinations in the PTO as well as to infringement determinations in court. *In re Donaldson Co. Inc.*, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994).

## 3. Discussion

Independent claim 1 calls for a combination of element including, *inter alia*, control means ... ***for electronically altering energy transmission from the [energy emitting] region between transmission as a zone of uniform polarity and transmission as zones of alternating polarity in response to the prescribed input command.*** Independent claim 12 calls for a combination of element including, *inter alia*, control means ... ***for selectively electronically altering the energy transmitting characteristics of the region to block transmission from portion of the region while allowing transmission from another portion of the region.***

Applicant respectfully submits that the above-noted rejection is improper because, even assuming that there was motivation to combine the cited references, the proposed combination of references simply fails to result in the claimed combination of elements. As discussed in detail below, the combined teachings of the references fail both portions of the means-plus-function test. The cited references do not teach or suggest the respective functions defined by the means-plus-function portions of independent claims 1 and 12, nor do they teach or suggest means identical to, or the equivalent of, the structure material, or acts described in the present specification.

Turning first to the respective functions recited in the means-plus-function portions of independent claims 1 and 12, the Houser patent does not teach or suggest alternating between a zone of uniform polarity and zones of alternating polarity in response to a command. Nor does the Houser patent teach or suggest selectively blocking transmission from one portion of an energy transmitting region, while allowing transmission from another. With respect to structure, there is nothing in the Houser patent that suggests that the generic controller 14 shown in FIG. 1 could be used to perform these functions.

The above-described deficiencies in the Houser patent simply are not remedied by the Mackey article, which merely discloses that RF energy delivered in multipolar fashion will produce larger lesions than RF energy delivered to the distal tip alone. With respect to independent claim 1, nothing in the Mackey article even remotely suggests the function of alternating between a zone of uniform polarity and zones of alternating polarity ***in response to an input command***. In fact, the Mackey article does not teach switching between uniform polarity and alternating polarity at all. The article merely suggests the superiority of one mode of operation over another in certain situations. As for independent claim 12, the Mackey article does not suggest the function of selectively blocking transmission from one portion of an energy transmitting region, while allowing transmission from another. Again, the Mackey article simply states that multipolar RF energy will produce larger lesions than RF energy delivered to the distal tip alone.

With respect to structure for performing the claimed function, the Mackey article fails to disclose any structure whatsoever, let alone structure that would lead one of skill in the art from the structure disclosed in the Houser patent to the structure described in the present application, or the equivalents thereof.<sup>1</sup>

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<sup>1</sup> Additionally, to the extent that the conclusory statements in the Office Action indicate that the Examiner has taken "judicial notice" with respect to knowledge generally available in the catheter control device art, applicant hereby requests that the Examiner provide an affidavit in accordance with MPEP § 706.02(a) and 37 C.F.R. § 1.107(b) to that effect. The affidavit should set forth the facts upon which the

#### **4. Conclusion**

As the Houser and Mackey references fail to teach or suggest the combination of elements recited in independent claims 1 and 12, whether viewed alone or in combination, applicant respectfully submits that the rejection of claims 1-20 under 35 U.S.C. § 103 must be withdrawn.

#### **V. NEWLY PRESENTED CLAIMS 28-32**

Newly presented independent claim 28 calls for a combination of elements including, *inter alia*, a guide element for introduction into a body, a plurality of electrodes on the guide element, and a controller operably connected to the plurality of electrodes and to a source of tissue ablating energy ... the controller including switching means for selectively disconnecting at least one of the electrodes from the source of tissue ablating energy in response to a first predetermined input command. As discussed in details in Sections III and IV above, the cited references fail to teach or suggest such a combination. As such, applicant respectfully submits that claims 28-32 are patentable thereover.

#### **VI. CLOSING REMARKS**

In view of the foregoing, it is respectfully submitted that the claims in the application patentably distinguish over the cited and applied references and are in condition for allowance. Reexamination and reconsideration of the application, as

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Examiner's conclusions regarding the knowledge available in the art are based. Otherwise, applicant respectfully requests that the Examiner provide a prior art reference which shows that the claimed invention would have been obvious.

amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

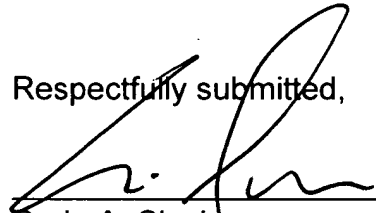
If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call Applicant's undersigned representative at (310) 788-5070 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 16-2230. Should such additional fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefore.

9/4/97  
Date

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Respectfully submitted,

  
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